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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/010,068 | 12/06/2001 | Peter M. Karas | 020375-000610US | 3210 |
| 20350 | 7590 | 12/13/2005 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | POND, ROBERT M | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3625 | | |

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/010,068 | KARAS ET AL. | |
| | Examiner | Art Unit | |
| | Robert M. Pond | 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 September 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24, 26-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24, 26-28 and 30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/02/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant canceled claims 25 and 29, and amended claims 10 and 18. All pending claims 1-24, 26-28, and 30 were examined in this final office action necessitated by amendment.

Response to Arguments

Pertaining to Rejection under 35 USC 102 in the previous office action

Rejection under 35 USC 102 is withdrawn as necessitated by amendment. Messner in view of Van Dusen further in view of Walker teach and suggest the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. **Claims 1-24, 26-28, and 30 are rejected under 35 USC 103(a) as being unpatentable over Messner (Paper #20050527,US 6,370,514) in view of Van Dusen (US 6,175,823), further in view of Walker (US 6,193,155).**

Messner teaches electronic email distribution of electronic gift certificates or coupons to recipients via virtual cards containing messages (please note examiner's interpretation: greeting cards). Messner further teaches:

- receiving selection of the electronic greeting card from a sender: (see at least col. 9, lines 1-17).
- receiving selection of a type of electronic gift from a plurality of gift types: gift certificate for selection among a plurality of gifts or coupon for discounts from among a plurality of gifts (see at least col. 5, lines 19-30; col. 8, lines 17-19; col. 6, lines 59-67).
- receiving payment for the electronic gift from a money handler chosen by the sender: sender chooses payment method (see at least Fig. 1B, col. 8, lines 58-59).
- creating a code indicative of the electronic gift, whereby the code facilitates redemption of the electronic gift: account number with certificate delivered separately from password (see at least col. 6, lines 41-58).
- embedding the code in the electronic greeting card: certificate containing embedded code is delivered with virtual card (see at least col. 6, lines col. 9, lines 1-5).
- embedded code includes a link to the site involved with redemption of the electronic gift: (see at least col. 8, lines 17-34).
- Receiving fee: fee or interest paid to service from central account (see at least col. 12, lines 12-30).

- *future time*: virtual card with message sent via email to recipient on date specified by sender (see at least col. 9, lines 9-17).
- *delivery address*: sender provides sender email address. Inherent in Messner are the structures necessary to permit the sender to provide a recipient email address to the online service necessary for the delivery of the email to the recipients email address. For example, the service delivers the virtual card with gift certificate to the recipient via email as previously noted above.
- *first identity and second identity for verification*: processing recipient email address as noted above as a first identity; sender types personalized question and answer (second identity), presents question to recipient requesting answer as second identity to validate recipient (see at least col. 6, lines 50-58; col. 9, lines 18-50).
- *Plurality of gift types*: gift certificate value backed by stored value fund (e.g. debit account) (see at least col. 8, lines 58-59).
- *HTML*: web pages, web server, HTML, and links (see at least col. 2, line 2; col. 12, lines 65-67).
- *Money handlers*: gift certificate issuer (e.g. brick and mortar store, virtual mall, or voucher server) (see at least col. 8, lines 58-67).
- *Payment system*: voucher server separate from account server (see at least Fig. 3 (38, 54); col. 7, lines 17-42).

- Computer readable medium: Inherent in Messner are the structures necessary that permit executable code to be embodied on computer readable medium.

Messner teaches all the above as noted under the 103(a) rejection and further teaches a) using electronic links by the recipient to connect with either the voucher server or a web merchant for electronic gift certificate redemption, and b) the electronic gift certificate being preferably able to electronically direct the recipient to the web page showing the product in question, but does not specifically disclose an embedded code in the gift certificate that links the recipient to redemption site. Van Dusen teaches recipients redeeming electronic gift certificate from the Amazon.com web site. Van Dusen further teaches the electronic gift certificate containing an embedded code that links the recipient to a redemption site. Van Dusen further teaches eliminating the need for the recipient to manually enter the claim code as a benefit and thereby providing a more convenient redemption process (see at least abstract; col. 1, line 54 through col. 2, line 15). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Messner to embed a code that links the recipient to a redemption site as taught by Van Dusen, in order to eliminate the need for the recipient to manually enter the claim code, and thereby attract consumers to the service by providing a more convenient redemption process.

Messner and Van Dusen teach all the above as noted under the 103(a) rejection and teach a) certificate redemption whereby the recipient can draw against the account in the form of redemption purchases until the balance is depleted, and b) convenience for recipients, but do not disclose a money handler chosen from two criteria. Walker teaches gift certificate redemption and further teaches stored value cards and cash redemption (see at least abstract; col. 8, lines 63-64; col. 9, line 35). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Messner and Van Dusen to identify other aspects of money handling associated with gift redemption as taught by Walker, in order to provide additional consumer convenience, and thereby attract more consumers to the service.

Pertaining to claims 17-22, 28, and 30

Rejection of claims 17-22, 28, and 30 is based on the same rationale as noted above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond
Primary Examiner
December 1, 2005